Motions, Pleadings and Filings

United States District Court,
S.D. New York.
PLANNED PARENTHOOD FEDERATION OF AMERICA, INC., Plaintiff,
v.
Richard BUCCI, d/b/a Catholic Radio Defendant.
No. 97 Civ. 0629 (KMW).

March 24, 1997.

OPINION & ORDER

KIMBA M. WOOD, District Judge.

***1** Plaintiff Planned Parenthood Federation of America, Inc. ("Planned Parenthood") has moved to preliminarily enjoin defendant Richard Bucci ("Bucci"), doing business as Catholic Radio, from using the domain name "plannedparenthood.com," and from identifying his web site on the Internet under the name "www.plannedparenthood.com." The Court held a hearing on February 20, 1997 and February 21, 1997, [FN1] and now issues the preliminary injunction sought by Planned Parenthood.

FN1. The Court held a hearing on plaintiff's request for a temporary restraining order on February 5, 1997.

I. Undisputed Facts

The parties do not dispute the following facts. Plaintiff Planned Parenthood, founded in 1922, is a non-profit, reproductive health care organization that has used its present name since 1942. Plaintiff registered the stylized service mark "Planned Parenthood" on the Principal Register of the United States Patent and Trademark Office on June 28, 1955, and registered the block service mark "Planned Parenthood" on the Principal Register of the United States Patent and Trademark Office on September 9, 1975. Plaintiff's 146 separately incorporated affiliates, in 48 states and the District of Columbia, are licensed to use the mark "Planned Parenthood." Plaintiff expends a considerable sum of money in promoting and advertising its services. The mark "Planned Parenthood" is strong and incontestable.

Plaintiff operates a web site at "www.ppfa.org," using the domain name "ppfa.org." Plaintiff's home page offers Internet users resources regarding sexual and reproductive health, contraception and family planning, pregnancy, sexually transmitted diseases, and abortion, as well as providing links to other relevant web sites. In addition, plaintiff's home page offers Internet users suggestions on how to get involved with plaintiff's mission and solicits contributions. [FN2]

FN2. Plaintiff's Houston affiliate owns the domain name "plannedparenthood.org," and is in the process of transferring that domain name to plaintiff. Tr. 2/20/97 at 14.

Defendant Bucci is the host of "Catholic Radio," a daily radio program broadcast on the WVOA radio station in Syracuse, New York. Bucci is an active participant in the anti-abortion movement. Bucci operates web sites at "www.catholicradio.com" and at "lambsofchrist.com." On August 28, 1996, Bucci registered the domain name "plannedparenthood.com" with Network Solutions, Inc. ("NSI"), a corporation that administers the assignment of domain names on the Internet. After registering the domain name, Bucci set up a web site and home page on the Internet at the address "www.plannedparenthood.com."

Internet users who type in the address

"www.plannedparenthood.com," or who use a search engine such as Yahoo or Lycos to find web sites containing the term "planned parenthood," can reach Bucci's web site and home page. Once a user accesses Bucci's home page, she sees on the computer screen the words "Welcome to the PLANNED PARENTHOOD HOME PAGE!" [FN3] These words appear on the screen first, because the text of a home page downloads from top to bottom. Tr. 2/20/97 at 47. Once the whole home page has loaded, the user sees a scanned image of the cover of a book entitled *The Cost of Abortion,* by Lawrence Roberge ("Roberge"), under which appear several links: "Foreword," "Afterword," "About the Author," "Book Review," and "Biography."

FN3. The text of defendant's home page is part of the record before the Court, as Pl.Ex. 2.

***2** After clicking on a link, the user accesses text related to that link. By clicking on "Foreword" or "Afterword," the Internet user simply accesses the foreword or afterword of the book *The Cost of Abortion.* That text eventually reveals that *The Cost of Abortion* is an anti-abortion book. The text entitled "About the Author" contains the curriculum vitae of author Roberge. It also notes that "Mr. Roberge is available for interview and speaking engagements," and provides his telephone number.
The "Book Review" link brings the Internet user to a selection of quotations by various people endorsing *The Cost of Abortion.* Those quotations include exhortations to read the book and obtain the book. "Biography" offers more information about Roberge's background.

II. Disputed Facts

The parties dispute defendant's motive in choosing plaintiff's mark as his domain name. Plaintiff alleges that defendant used plaintiff's mark with the "specific intent to damage Planned Parenthood's reputation and to confuse unwitting users of the Internet." Pl. Rep. Mem. at 2. Discussing the difference between the domain name at issue here and defendant's other web sites, defendant's counsel states that "[t]he WWWPLANNNEDPARENTHOOD.COM [sic] website ... enables Defendant's message to reach a broader audience." Def. Mem. in Opp. at 3. Defendant's counsel made the following statement to the Court regarding defendant's use of plaintiff's mark to designate his web site:

> My belief is that it was intended to reach people who would be sympathetic to the proabortion position.... [I]t is an effort to get the ... political and social message to people we might not have been otherwise able to reach. I think it's analogous to putting an advertisement in the New York Times rather than The National Review.
> You are more likely to get people who are sympathetic to the proabortion position, and that's who you want to reach. I believe that is exactly what Mr. Bucci did when he selected Planned Parenthood. Tr. 2/5/97 at 23.

Defendant did not dispute that his counsel was correct in that statement. Tr. 2/21/97 at 35.
Defendant's counsel also admitted that Bucci was trying to reach Internet users who thought, in accessing his web site, that they would be getting information from plaintiff. *Id.* at 23-24.

Defendant stated that his motive in using plaintiff's mark as his domain name was "to reach, primarily, Catholics that are disobedient to the natural law." *Id.* at 21. In an affidavit submitted to the Court, defendant stated that he wanted his "anti-abortion message to reach as many people as possible, and particularly the people who do not think that abortion has an inimical effect on society." Def. Aff. at ¶ 3. [FN4] Defendant conceded that he was aware that by using plaintiff's mark to identify his web site, he was likely to draw in Internet users who are "pro-abortion." Tr. 2/21/97 at 36. [FN5] Defendant demonstrated full knowledge of plaintiff's name and activities, and admitted to an understanding that using plaintiff's mark as his domain name would attract "pro-abortion" Internet users to his web site because of their misapprehension as to the site's origin. *Id.* [FN6] I therefore now make the factual finding that defendant's motive in choosing plaintiff's mark as his domain name was, at least in part, to attract to his home page Internet users who sought *plaintiff's* home page.

FN4. In light of defendant's sworn affidavit, the Court does not find Bucci's statement that he "never gave [his] audience a thought," Tr. 2/21/97 at 26, credible.

FN5. The Court notes that defendant has submitted, as Exhibit 1 to his affidavit, a statement by his "spiritual adviser," Father Norman Weslin, that defendant wants to place on "www.plannedparenthood.com" web site. In that statement, Father Weslin explains that the web site "is considered a highly effective instrument by the Roman Catholic Church in exposing [plaintiff's] efforts which seek to impose the culture of death upon the culture of life and to inform not only the Roman Catholic faithful *but also those who are opposed to God's "planned parenthood ...."* (emphasis added).

FN6. In addition, after plaintiff contacted defendant about the use of its mark as a domain name, defendant made the following statement on his radio show, Catholic Radio: "Of course, we knew this would happen. We knew we would draw the fire of Planned Parenthood.... So we've got ourselves into a real fight. Hey listen, we're asking for it." Pl.Ex. 6A at 1.

III. Analysis

A. Standard for Preliminary Injunction

***3** In order to obtain a preliminary injunction, a movant must demonstrate "(a) irreparable harm and (b) either (1) likelihood of success on the merits or (2) sufficiently serious questions going to the merits to make them a fair ground for litigation and a balance of hardships tipping decidedly toward the party requesting the preliminary injunction." *Hasbro, Inc. v. Lanard Toys. Ltd.,* 858 F.2d 70, 73 (2d Cir.1988) (internal citations omitted). In cases brought under the Lanham Act, a showing of likelihood of confusion establishes both a likelihood of success on the merits and irreparable harm, once the plaintiff has established that it has a protectible mark. *Id.* at 73. Because defendant concedes that plaintiff's mark is protectible, the inquiry before me is twofold: (1) whether the Lanham Act is applicable here, and (2) is there a likelihood of confusion? I now address these questions.

B. Whether the Lanham Act is Applicable

Defendant argues that his use of plaintiff's mark cannot be reached under the Lanham Act because it is non-commercial speech. Planned Parenthood has brought suit under §§ 1114, 1125(a), and 1125(c) of the Lanham Act, Title 15, United States Code. Section 1114 of the Lanham Act forbids a party to *"use in commerce* any reproduction, counterfeit, copy, or colorable imitation of a registered mark *in connection with the sale, offering for sale, distribution, or advertising of any goods or services* on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive." (Emphasis added). An injunction under § 1125(c) is proper to stop *"commercial use in commerce* of a mark or trade name" if that use causes dilution of a famous mark. (Emphasis added). Finally, with respect to § 1125(a), defendant may be liable if he has used the plaintiff's mark *"in commerce"* in a way that either "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her *goods, services, or commercial activities* by another person," § 1125(a)(1)(A), or "*in commercial advertising or promotion,* misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's *goods, services, or commercial activities,"* § 1125(a)(1)(B). (Emphasis added). Section 1125(c)(4)(B) specifically exempts from the scope of all provisions of § 1125 the "*noncommercial use* of a mark." (Emphasis added).

As a preliminary matter, I note that although the parties agreed at a hearing before me on February 21, 1997 that defendant's use of plaintiff's mark is "in commerce" within the meaning of the Lanham Act, Tr. 2/21/97 at 77, defendant now argues that his activities are not subject to the Lanham Act because they are not "in commerce." I find this argument meritless. The "use in commerce" requirement of the Lanham Act is a jurisdictional predicate to any law passed by Congress. It is well settled that the scope of "in commerce" as a jurisdictional predicate of the Lanham Act is broad and has a sweeping reach. *Steele v. Bulova Watch Co.,* 344 U.S. 280, 283, 73 S.Ct. 252, 97 L.Ed. 319 (1952). The activity involved in this action meets the "in commerce" standard for two reasons. First, defendant's actions affect plaintiff's ability to offer plaintiff's services, which, as health and information services offered in forty-eight states and over the Internet, are surely "in commerce." Thus, even assuming, *arguendo,* that defendant's activities are not in interstate commerce for Lanham Act purposes, the effect of those activities on *plaintiff's* interstate commerce activities would place defendant within the reach of the Lanham Act. *See Franchised Stores of New York. Inc. v. Winter,* 394 F.2d 664, 669 (2d Cir.1968). Second, Internet users constitute a national, even international, audience, who must use interstate telephone lines to access defendant's web site on the Internet. The nature of the Internet indicates that establishing a typical home page on the Internet, for access to all users, would satisfy the Lanham Act's "in commerce" requirement. *See Intermatic v. Toeppen,* 947 F.Supp. 1227, 1239 (N.D.Ill.1996), *quoting* 1 Gilson, Trademark Protection and Practice, § 5.11(2), p. 5-234 ("there is little question that the 'in commerce' requirement would be met in a typical Internet message"). Therefore, I conclude that defendant's actions are "in commerce" within the meaning of that term for jurisdictional purposes. [FN7] I now turn to the specific language of each provision of the Lanham Act under which plaintiff has brought suit.

FN7. Defendant argues that the Court should define "use in commerce" as it is defined in 15 U.S.C. § 1127. There, Congress defines the "use [of a mark] in commerce" as, *inter alia,* its use "on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services."

Plaintiff notes that the narrower definition of "use in commerce" as set out in § 1127 has been used by the Patent and Trademark Office in initially determining whether a mark qualifies for federal registration. *See, e.g., ConAgra. Inc. v. George A. Hormel & Co.,* 990 F.2d 368, 371 (8th Cir.1993); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition,* § 25:57 (3d ed. 1996) ("It is difficult to conceive of an act of infringement which is not 'in commerce' in the sense of the modern decisions.... However, the Patent and Trademark Office still appears to adopt a higher standard of use in commerce for purposes of qualifying for federal registration in the first instance.")

In any event, I note that defendant satisfies the requirements of § 1127. First, his activities over the Internet occur everywhere that Internet users may access his web site. Testimony has shown that Internet users in Texas, Tr. 2/20/97 at 17, Massachusetts, *id.* at 46, and Delaware, *id.* at 52, have accessed defendant's home page. Second, defendant is "engaged in commerce" in connection with his web site due to his use of the Internet and his effect on plaintiff's activities, because those activities constitute commerce within the meaning of § 1127, which defines "commerce" as "all commerce which may lawfully be regulated by Congress."

1. Section 1114

***4** Notwithstanding its jurisdictional "in commerce" requirement, Section 1114 contains no commercial activity requirement; rather, it prohibits any person from, without consent of the registrant of a mark, using the mark "in connection with the sale, offering for sale, distribution, or advertising of any good or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive." The question the Court must decide, then, is whether defendant's use of plaintiff's mark is properly viewed as in connection with the distribution or advertising of goods or services.

Defendant's use of plaintiff's mark satisfies the requirement of § 1114 in a variety of ways. First, defendant has stated that he chose to place materials about *The Cost of Abortion* on the "www.plannedparenthood.com" web site because he wanted to help Roberge "plug" his book. Tr. 2/21/97 at 25. In addition, defendant agreed that he, by this activity, was helping the author sell his book. *Id.* at 30. Although defendant receives no money from any sales of the book that result from its exposure on his home page, there is no personal profit requirement in § 1114. The materials on the home page, which are similar to a publisher's publicity kit, certainly relate to the advertisement and distribution of *The Cost of Abortion.*

Second, defendant's home page is merely one portion of his, and Catholic Radio's, broader effort to educate Catholics about the anti-abortion movement. With respect to that effort, defendant solicits funds and encourages supporters to join him in his protest activities. *Id.* at 16. Much like plaintiff, defendant has a practical as well as a political motive. While plaintiff seeks to make available what it terms "reproductive services," including, *inter alia,* birth control and abortion services, defendant offers informational services for use in convincing people that certain activities, including the use of plaintiff's services, are morally wrong. In this way, defendant offers his own set of services, and his use of plaintiff's mark is in connection with the distribution of those services over the Internet. *See MGM-Pathe Communications v. Pink Panther Patrol,* 774 F.Supp. 869 (S.D.N.Y.1991) (holding that a group formed to offer the free service of protecting gay individuals from assault was subject to § 1114).

In addition, defendant's use of plaintiff's mark is "in connection with the distribution of services" because it is likely to prevent some Internet users from reaching plaintiff's own Internet web site. Prospective users of plaintiff's services who mistakenly access defendant's web site may fail to continue to search for plaintiff's own home page, due to anger, frustration, or the belief that plaintiff's home page does not exist. One witness explained, "We didn't resume the search [for plaintiff's web site] after [finding defendant's web site] because ... we were pretty much thrown off track." Tr. 2/20/97 at 49. Therefore, defendant's action in appropriating plaintiff's mark has a connection to *plaintiff's* distribution of its services. For these reasons, § 1114 is applicable to defendant's use of plaintiff's mark.

2. Section 1125(c)

***5** Section 1125(c), the Lanham Act's anti-dilution provision, provides that the owner of a famous mark is entitled to an injunction against another person's "commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark." The provision has no requirement that there be advertising or a sale of goods or services. Defendant argues that his use is not "commercial" within the meaning of § 1125(c). I hold, however, that defendant's use of plaintiff's mark is "commercial" for three reasons: (1) defendant is engaged in the promotion of a book, (2) defendant is, in essence, a non-profit political activist who solicits funds for his activities, and (3) defendant's actions are designed to, and do, harm plaintiff commercially.

First, as discussed above, defendant's home page is a showcase for *The Cost of Abortion,* offering excerpts of the book, information about the author (specifically including how to contact the author for speaking engagements), and endorsements of the book (including statements such as "I want to see this book in the hands of EVERY Catholic priest and Protestant minister in the country"). This showcase is surely commercial in nature, despite the fact that defendant derives no monetary gain from these activities. Although defendant does not seek a profit from his actions, § 1125(c) carries no "for-profit" requirement. Therefore, defendant's use of plaintiff's mark to further his self-styled effort to "plug" *The Cost of Abortion* falls within the purview of the commercial use requirement of § 1125(c).

Second, defendant's use of plaintiff's mark to identify his web site is one part of defendant's sustained effort, through his radio show and other means, to achieve his end of persuading the public to eschew birth control and abortion. Defendant is a vocal supporter of the anti-abortion movement. Tr. 2/21/97 at 14. Defendant also opposes the use of contraceptives. *Id.* at 15. Through his radio program, he seeks to educate his listeners about the teachings of the Catholic church, specifically trying to discourage his audience from using birth control and obtaining abortions. *Id.* at 14-15. In this connection, defendant is a vocal critic of plaintiff and plaintiff's activities. *Id.* at 15-16.

In *MGM-Pathe,* 774 F.Supp. 869, Judge Leval considered whether a non-profit group that uses another's trademark in support of its own non-profit aims is subject to the Lanham Act. Specifically, he examined whether a group whose aim was to provide protection to the gay community and to educate the general public about violence against that community could appropriate a part of the name of a movie produced by plaintiff ("Pink Panther"). After finding that there was a likelihood of confusion, Judge Leval concluded that defendant's goal of political activism did not confer immunity from the Lanham Act, noting that "[t]he seriousness and virtue of a cause do not confer any right to the use of the trademark of another." *Id.* at 877. Defendant attempts to distinguish *MGM-Pathe* from the case now before the Court on the ground that defendant in this action has used plaintiff's mark in an effort to criticize plaintiff, while the *MGM-Pathe* defendants had no intent to criticize the Pink Panther movies. The Court finds this distinction unhelpful. The mere fact that defendant seeks to criticize plaintiff cannot automatically immunize a use that is otherwise prohibited by the Lanham Act.

***6** Additionally, defendant has testified that he solicits contributions on his "Catholic Radio" radio show and has solicited contributions on the air in connection with the instant lawsuit. Tr. 2/21/97 at 16. Defendant's ownership of the domain name "plannedparenthood.com" is part and parcel of Catholic Radio's broader efforts in the anti-abortion movement. Specifically, defendant has told his radio listeners that "Catholic Radio owns the name 'Planned Parenthood.' " Pl.Ex. 6A. [FN8] Courts have found that fund-raising activities may bring a defendant's actions within the scope of the Lanham Act. *See Cancer Research Institute. Inc. v. Cancer Research Society, Inc.,* 694 F.Supp. 1051 (S.D.N.Y.1988) (enjoining defendant from using plaintiff's name for soliciting funds for cancer research), *Girls Club of Am., Inc. v. Boys Clubs of Am., Inc.,* 683 F.Supp. 50, 53 (S.D.N.Y.), *aff'd,* 859 F.2d 148 (2d Cir.1988) (enjoining defendant from adding plaintiff's name to its own for broad range of non-profit activities including fundraising); *Brach van Houten Holding v. Save Brach's Coalition,* 856 F.Supp. 472 (N.D.Ill.1994) (enjoining defendant from use of plaintiff's name in soliciting funds); *American Diabetic Assoc. v. National Diabetic Assoc.,* 533 F.Supp. 16, 20 (E.D.Pa.1981) (enjoining defendant from use of similar name in relation to its non-profit fund-raising). I find that defendant's use of plaintiff's mark is sufficiently tied to defendant's fund-raising efforts for the use to be deemed "commercial" within the meaning of § 1125(c).

FN8. Plaintiffs' Exhibit 6A is a transcript of a cassette tape, Pl.Ex. 6, labeled "Bucci Catholic Radio January 9, 1997." That tape contains a portion of defendant's Catholic Radio broadcast describing Catholic Radio's ownership of the domain name "plannedparenthood.com." Defendant, on that broadcast, asks his audience for "suggestions on how to make the most of this Web site," and says, "if any of you folks out there have any, any ideas how we can make the most of this Web site, please contact me." Pl.Ex. 6A at 1-2.

Finally, defendant's use is commercial because of its effect on plaintiff's activities. First, defendant has appropriated plaintiff's mark in order to reach an audience of Internet users who want to reach plaintiff's services and viewpoint, intercepting them and misleading them in an attempt to offer his own political message. Second, defendant's appropriation not only provides Internet users with competing and directly opposing information, but also prevents those users from reaching plaintiff and its services and message. In that way, defendant's use is classically competitive: he has taken plaintiff's mark as his own in order to purvey his Internet services--his web site--to an audience intending to access plaintiff's services.

I note that although defendant relies on the holding of *Panavision Int'l, L.P. v. Toeppen,* 945 F.Supp. 1296 (C.D.Cal.1996) for the proposition that registering a domain name is not a commercial use within the meaning of the anti-dilution provision of the Lanham Act, *Panavision* is not controlling in this case. Defendant simply ignores the fact that he has done more than merely register a domain name; he has created a home page that uses plaintiff's mark as its address, conveying the impression to Internet users that plaintiff is the sponsor of defendant's web site. The *Panavision* court noted that the "exception for noncommercial use of a famous mark is intended to prevent courts from enjoining constitutionally-protected speech." *Id.* at 1303. However, whether defendant's use of the mark is commercial within the meaning of the Lanham Act is a distinct question from whether defendant's use of the mark is protected by the First Amendment; I reach the latter question below. The holding of *Panavision* does not suggest that defendant's use of plaintiff's mark is not commercial.

3. Section 1125(a)(1)(A)

***7** In relevant part, § 1125(a)(1)(A) prohibits a person from using in commerce any term or false designation of origin which "is likely to cause confusion ... as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person." Section 1125(a)(1) is also limited by § 1125(c)(4)(B), which states that "noncommercial use of a mark" is not actionable under the Lanham Act.

Here, as discussed above, defendant offers informational services relating to the anti-abortion and anti-birth control movement, specifically providing his audience with relevant literature and the means to contact Roberge. In addition, defendant's solicitation of funds in relation to his anti-abortion efforts are commercial in nature. Therefore, because defendant's labelling of his web site with plaintiff's mark relates to the "origin, sponsorship, or approval" by plaintiff of defendant's web site, I find that § 1125(a)(1)(A) may govern defendant's actions in this case.

4. Section 1125(a)(1)(B)

With respect to § 1125(a)(1)(B), defendant can be liable only if he has used the plaintiff's mark "in commercial advertising or promotion." Courts have disagreed as to the scope and meaning of "commercial advertising and promotion." *Compare Seven-Up Co. v. Coca-Cola Co.,* 86 F.3d 1379, 1384 (5th Cir.1996) (defining commercial advertising as commercial speech, by a defendant in commercial competition with plaintiff, for purpose of influencing consumers to buy defendant's goods or services) *with Semco, Inc. v. Amcast, Inc.,* 52 F.3d 108, 111-12 (6th Cir.1995) (noting conflicting legislative history of § 1125(a)(1)(B) as to whether commercial advertising is merely coextensive with commercial speech, or includes all speech that is not political). Because I have concluded that defendant's activity is subject to the provisions of the Lanham Act discussed above, I need not reach the issue of whether his activity is subject to § 1125(a)(1)(B). I therefore do not address the issue of the meaning of "commercial advertising and promotion."

I therefore determine that § 1114, § 1125(c), and § 1125(a)(1)(a) of the Lanham Act are applicable here. I turn now to whether defendant's use of plaintiff's mark results in a likelihood of confusion.

C. The Likelihood of Confusion

1. The Polaroid Factors

The Second Circuit set out the factors a court must consider in determining the likelihood of consumer confusion in *Polaroid Corp. v. Polarad Elecs. Corp.,* 287 F.2d 492, 495 (2d Cir.1961). Those factors include: the strength of plaintiff's mark, the degree of similarity between the two marks, the competitive proximity of the products or services, the likelihood that the plaintiff will bridge the gap between the two markets, the existence of actual confusion, the defendant's good faith in adopting the mark, the quality of the defendant's product, and the sophistication of the purchasers.

a. The Strength of the Mark

***8** The strength of plaintiffs' mark is conceded by defendant, which is reasonable in light of plaintiffs' trademark registration of the mark and plaintiffs' continued use of the mark for over 50 years. Tr. 2/20/97 at 7-9. The strength of plaintiffs' mark weighs in favor of likelihood of confusion.

b. The Degree of Similarity Between the Marks

The two marks, "Planned Parenthood" and "plannedparenthood.com "are nearly identical; the only distinctions are the latter's lack of initial capitalization, the lack of a space between words, and the ".com" that is necessary to designate a domain name. The degree of similarity between defendant's domain name and the domain name owned by plaintiff's affiliate, Planned Parenthood of Houston, "plannedparenthood.org," is even stronger. [FN9] Plaintiff was originally under the impression that according to Internet usage, it could operate using only a ".org" designation. Tr. 2/20/97 at 14. Currently, however, NSI allows non-profit corporations, as well as for-profit businesses and individuals, to use the ".com" designation. *Id.* The ".com" designation is commonly used by businesses. *Id.* at 48. The degree of similarity between the marks thus increases the likelihood of confusion among Internet users.

FN9. In comparing plaintiff's product with defendant's product, the Court looks to the "www.ppfa.org" web site and the "www.plannedparenthood.com" website.

c. The Competitive Proximity of the Products or Services

The web sites of plaintiff and defendant are both located on the World Wide Web. Therefore, defendant's web site at "www.plannedparenthood.com" is close in proximity to plaintiff's own web site, "www.ppfa.org." Both sites compete for the same audience--namely, Internet users who are searching for a web site that uses plaintiff's mark as its address. The degree of competitive proximity, therefore, increases the likelihood of confusion among Internet users.

d. The Likelihood that Plaintiff Will Bridge the Gap Between the Markets

Because plaintiff's web site and defendant's web site are both on the Internet, the parties are vying for users in the same "market." Where the market for competing goods or services is the same, there is no need to consider whether plaintiff will bridge the gap between the markets. *Paddington Corp. v. Attiki Importers & Distributors, Inc.,* 996 F.2d 577, 586 (2d Cir.1993). I therefore do not consider this factor in determining the likelihood of confusion.

e. The Existence of Actual Confusion

Plaintiff has produced testimony demonstrating that actual confusion has occurred among Internet users. Tr. 2/20/97 at 47-49, 54-57. The confusion has occurred both in a user who attempted to go directly to "www.plannedparenthood.com," thinking that it was likely to be plaintiff's web address, *Id.* at 46, and in a user who used a search engine to find web sites containing, or designated by, plaintiff's mark. *Id.* at 53-54.

This specific testimony exemplifies the likelihood of confusion due to the nature of domain names and home page addresses. First, because ".com" is a popular designation for Internet domain names, an Internet user is likely to assume that ".com" after a corporation's name will bring her to that corporation's home page, if one exists. [FN10] Second, an Internet user cannot immediately determine the content of a home page maintained by the owner of a particular domain name or located at a specific address. Only after a user has seen or entered "plannedparenthood.com" can she access the web site; such access occurs after at least a temporary delay. In addition, there is a delay while the home page "loads" into the computer. Because the words on the top of the page load first, the user is first greeted solely with the "Welcome to the Planned Parenthood Home Page!" It is highly likely that an Internet user will still believe that she has found plaintiff's web site at that point.

FN10. A vast number of corporations use their corporate name, or some easily recognizable variant thereof, followed by ".com," as a domain name and home page address. Therefore, a typical Internet user who wants to go to a corporation's home page may attempt to find the page by simply typing into her computer "www.[corporation name].com". Examples of such home page addresses include: "www.nytimes.com," "www.mtv.com," "www.randomhouse.com," "www.sony.com," "www.harrys-shoes.com," and "www.mercuryvehicles.com."

***9** Even when the picture of *The Cost of Abortion* finally does appear on the screen, the user is unlikely to know that she is not at plaintiff's home page. *Id.* at 19, 47, 55-56. The book's ambiguous title "The Cost of Abortion," alone, cannot disabuse every Internet user of the notion that she has found plaintiff's home page. The Internet user must actually click on a link to read excerpts from the book, biographical information about the author, or book endorsements. only in the course of reading those items can the user determine that she has not reached plaintiff's home page. Depending on which link the user has chosen to access, there may be an additional delay before the user can grasp that plaintiff is not the true provider of the home page. [FN11] This lengthy delay between attempting to access plaintiff's home page and learning that one has failed to do so increases the likelihood of consumer confusion.

FN11. Defendant himself agreed that after clicking on the first link listed on the home page, the "Foreword," a user would not ascertain the anti-abortion message until the middle of the second paragraph. Tr. 2/21/97 at 42-43.

Similarly, the "Book Review" link contains endorsements that are ambiguous. "The concerns which [the author] raises affect EVERY American who cares about this country's future prosperity," reads one quote; another notes, "This well reasoned exposition should be read by thoughtful people on both sides of the issue."

f. The Defendant's Good Faith in Adopting the Mark

Defendant's testimony, and his counsel's admission at the hearing before this Court on the temporary restraining order, show that defendant chose his domain name and home page name with full knowledge and intent that some Internet users seeking to find *plaintiff's* home page would instead encounter *his.* However, defendant may have acted under the good faith assumption that his actions were protected by the First Amendment. I need not conclude that defendant acted in bad faith to conclude that there is a likelihood of confusion, and I therefore make no such finding at this time.

g. The Quality of Defendant's Product

A comparison of the quality of plaintiff's and defendant's products--their web sites--is irrelevant; the Court cannot compare the two web sites in terms of superior or inferior quality. However, I note that the two products are vastly different and convey quite divergent messages. Plaintiff's web site offers educational resources, suggests ways to get involved in plaintiff's activities, to join plaintiff in its advocacy mission, and to contribute to plaintiff, and offers links to plaintiff's local affiliates, related organizations, and job listings. In sum, plaintiff's web site provides Internet users with an array of information and services related to Planned Parenthood's mission of providing reproductive choice for women. Defendant's home page bearing plaintiff's mark offers users information, including an advertisement for a book, and ways to contact a vocal anti-abortion advocate. Any ensuing confusion resulting from defendant's use of plaintiff's mark as his domain name and home page address is likely to be destructive to the image that plaintiff, the senior user of the mark, has established. *See MGM-Pathe,* 774 F.Supp. at 876.

h. The Sophistication of the Purchasers

Plaintiff argues that its primary purchasers are low income, relatively unsophisticated women. I note that those with access to the Internet may not be coextensive with the segment of the population to whom plaintiff normally offers its services; those with Internet access may be more sophisticated. However, testimony has shown that even sophisticated Internet users were confused by defendant's web site. Although the sophisticated Internet user may discover, after reading the text of one of the links on defendant's home page, that she has not reached plaintiff's web site, some users may not be so immediately perspicacious. Because the sophistication of the user is no guarantee, here, that the consumer will not be confused, I find that this factor is of limited value in determining whether the consumer is likely to be confused.

***10** In sum, I find that the bulk of the *Polaroid* factors demonstrate that there is a significant likelihood of confusion that warrants the granting of a preliminary injunction.

D. Defendant's Additional Defenses

Defendant also argues that his use of plaintiff's mark is protected from injunction because (1) it is a parody, and (2) it is protected speech under the First Amendment. I consider these arguments in turn.

1. The Parody Exception

Defendant argues that his use of the "planned parenthood" mark is not likely to confuse because it is similar to a parody. A parody "depends on a lack of confusion to make its point," and " 'must convey two simultaneous--and contradictory--messages: that it is the original, but also that it is not the original and is instead a parody.' " *Hormel Food Corp. v. Jim Henson Productions. Inc.,* 73 F.3d 497, 503 (2d Cir.1996) (internal citations omitted). Here, an Internet user may either find the defendant's web site through a search engine or may simply enter the words "planned parenthood" in the expectation that she will find the plaintiff's web site. Seeing or typing the "planned parenthood" mark and accessing the web site are two separate and nonsimultaneous activities. Furthermore, the greeting "Welcome to the Planned Parenthood Home Page!" does not immediately contradict an Internet user's assumption that she has accessed the plaintiff's home page. Only when an Internet user actually "clicks" on one of the topics and accesses commentary on *The Cost of Abortion* does she encounter defendant's message.

I am not persuaded by defendant's argument that the message of the home page provides an ironic and contrasting allusion to plaintiff, nor do I find convincing his argument that the banner heading of the home page is sarcastic. Similarly, I do not conclude that defendant's use of the term "planned parenthood" in the context described above is intended not to confuse the user into an association with plaintiff, but rather "to *reference* Plaintiff as the 'enemy.' " [FN12] Because defendant's use of "planned parenthood" does not convey the simultaneous message that the home page and web site are those of plaintiff and those of defendant, defendant's argument that his use of the mark is a parody fails. Thus, the *Polaroid* factors must govern the issue of whether there is a likelihood of confusion. Here, I have found that the *Polaroid* factors demonstrate that there is a likelihood of confusion that arises from defendant's use of the domain name "plannedparenthood.com," the home page address "www.plannedparenthood.com," and the banner at the top of the home page stating, "Welcome to the Planned Parenthood Home Page!"

FN12. Although counsel for defendant argued that defendant's use of plaintiff's mark was "merely to reference plaintiff as the enemy," Def. Mem. in Opp. at 14, defendant could not point to any portion of the home page that referred to plaintiff as the enemy. Tr. 2/21/97 at 45.

2. The First Amendment Exception

Defendant also argues that his use of the "planned parenthood" mark is protected by the First Amendment. As defendant argues, trademark infringement law does not curtail or prohibit the exercise of the First Amendment right to free speech. I note that plaintiff has not sought, in any way, to restrain defendant from speech that criticizes Planned Parenthood or its mission, or that discusses defendant's beliefs regarding reproduction, family, and religion. The sole purpose of the Court's inquiry has been to determine whether the use of the "planned parenthood" mark as defendant's domain name and home page address constitutes an infringement of plaintiff's trademark. Defendant's use of another entity's mark is entitled to First Amendment protection when his use of that mark is part of a communicative message, not when it is used to identify the source of a product. *Yankee Publishing. Inc. v. News America Publishing, Inc.,* 809 F.Supp. 267, 275 (S.D.N.Y.1992). By using the mark as a domain name and home page address and by welcoming Internet users to the home page with the message "Welcome to the Planned Parenthood Home Page!" defendant identifies the web site and home page as being the product, or forum, of plaintiff. I therefore determine that, because defendant's use of the term "planned parenthood" is not part of a communicative message, his infringement on plaintiff's mark is not protected by the First Amendment.

***11** Defendant argues that his use of the "Planned Parenthood" name for his web site is entitled to First Amendment protection, relying primarily on the holding of *Yankee Publishing,* 809 F.Supp. at 275. In that case, Judge Leval noted that the First Amendment can protect unauthorized use of a trademark when such use is part of an expression of a communicative message: "the Second Circuit has construed the Lanham Act narrowly when the unauthorized use of the trademark is for the purpose of a communicative message, rather than identification of product origin." *Id.* Defendant argues that his use of the "Planned Parenthood" name for his web site is a communicative message. However, *Yankee Publishing* carefully draws a distinction between communicative messages and product labels or identifications:

> When another's trademark ... is used without permission for the purpose of source identification, the trademark law generally prevails over the First Amendment. Free speech rights do not extend to labelling or advertising products in a manner that conflicts with the trademark rights of others.

Id. at 276. Defendant offers no argument in his papers as to why the Court should determine that defendant's use of "plannedparenthood.com" is a communicative message rather than a source identifier. His use of "plannedparenthood.com" as a domain name to identify his web site is on its face more analogous to source identification than to a communicative message; in essence, the name identifies the web site, which contains defendant's home page. The statement that greets Internet users who access defendant's web site, "Welcome to the Planned Parenthood Home Page," is also more analogous to an identifier than to a communication. For those reasons, defendant's use of the trademarked term "planned parenthood" is not part of a communicative message, but rather, serves to identify a product or item, defendant's web site and home page, as originating from Planned Parenthood.

Defendant's use of plaintiff's mark is not protected as a title under *Rogers v. Grimaldi,* 875 F.2d 994, 998 (2d Cir.1989). There, the Court of Appeals determined that the title of the film "Ginger and Fred" was not a misleading infringement, despite the fact that the film was not about Ginger Rogers and Fred Astaire, because of the artistic implications of a title. The Court of Appeals noted that "[f]ilmmakers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works.' *Id.* The Court of Appeals found that the use of a title such as the one at issue in *Rogers* was acceptable 'unless the title has no artistic relevance to the underlying work"; even when the title has artistic relevance, it may not be used to "explicitly mislead[ ] [the consumer] as to the source or content of the work." *Id.* Here, even treating defendant's domain name and home page address as titles, rather than as source identifiers, I find that the title "plannedparenthood.com" has no artistic implications, and that the title is being used to attract some consumers by misleading them as to the web site's source or content. Given defendant's testimony indicating that he knew, and intended, that his use of the domain name "plannedparenthood.com" would cause some "pro-abortion" Internet users to access his web site, Tr. 2/21/97 at 36, he cannot demonstrate that his use of "planned parenthood" is entitled to First Amendment protection.

***12** Because defendant's use of plaintiff's mark is subject to the Lanham Act, because the *Polaroid* factors demonstrate that there is a likelihood of confusion arising from defendant's use of plaintiff's mark, and because defendant has not raised a defense that protects his use of the mark, plaintiff has met its burden of demonstrating that a preliminary injunction against defendant's use of plaintiff's mark is warranted. *Hasbro,* 858 F.2d at 73.

E. Whether A Disclaimer Will Cure the Confusion

Defendant argues that a disclaimer, rather than an injunction, is the appropriate remedy here. I disagree. Due to the nature of Internet use, defendant's appropriation of plaintiff's mark as a domain name and home page address cannot adequately be remedied by a disclaimer. Defendant's domain name and home page address are external labels that, on their face, cause confusion among Internet users and may cause Internet users who seek plaintiff's web site to expend time and energy accessing defendant's web site. Therefore, I determine that a disclaimer on defendant's home page would not be sufficient to dispel the confusion induced by his home page address and domain name.

F. Attorneys' Fees

Plaintiff has requested costs, including attorneys' fees. When an injunction is granted pursuant to 15 U.S.C. § 1125, the court may award the relief provided in §§ 1117(a), including reasonable attorneys' fees in "exceptional cases" under 15 U.S.C. § 1117(a). According to the Second Circuit, "exceptional" circumstances include cases of willful infringement. *Bambu Sales, Inc. V. Ozark Trading Inc.,* 58 F.3d 849, 854 (2d Cir.1995).

There is insufficient evidence and/or legal briefing before me to determine that defendant's use of plaintiff's mark constitutes willful infringement. I therefore order plaintiff to submit to the Court, no later than April 7, 1997, any memorandum of law or factual submissions in support of its request for attorneys' fees. Defendant shall reply to that submission no later than April 21, 1997. Plaintiff's response, if any, is due on May 5, 1997. The parties are, of course, encouraged to settle the costs issue between themselves, if possible.

IV. Conclusion

For the foregoing reasons, I grant plaintiff's motion for a preliminary injunction. I hereby enjoin defendant, his agents, servants, employees, representatives, attorneys, related companies, successors, assigns, and all others in active concert or participation with him, (1) from using to identify defendant's web site, home page, domain name or in any other materials available on the Internet or elsewhere the Planned Parenthood® mark, any colorable imitation of the Planned Parenthood® mark, and any thing or mark confusingly similar thereto or likely to cause dilution of the distinctiveness of the Planned Parenthood® mark or injury to the business reputation of the Planned Parenthood Federation of America, Inc. or any of its affiliates; and (2) from representing by any means whatsoever that defendant, or any products or services offered by defendant, including information services provided via defendant's web site or the Internet, are associated in any way with plaintiff or its products or services, and from taking other action likely to cause confusion or mistake on the part of Internet users or consumers.

***13** The remaining relief sought by plaintiff will be the subject of further proceedings herein.

SO ORDERED:

Not Reported in F.Supp., 1997 WL 133313

(S.D.N.Y.), 65 USLW 2662, 42 U.S.P.Q.2d 1430

Motions, Pleadings and Filings (Back to top)

- 1:97cv00629 (Docket) (Jan. 29, 1997)

END OF DOCUMENT